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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/520,534  | 01/06/2005  | Klaus Elian          | 2004 MN 456 US      | 9642             |
| 48154   | 7590        | 02/23/2007           | EXAMINER            |                  |
| SLATER & MATSIL LLP<br>17950 PRESTON ROAD<br>SUITE 1000<br>DALLAS, TX 75252 |             |                      | VISCONTI, GERALDINA |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1752                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE                                      |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS  |             | 02/23/2007           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                |                  |  |
|------------------------------|--------------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.                | Applicant(s)     |  |
|                              | 10/520,534                     | ELIAN, KLAUS     |  |
|                              | Examiner<br>Geraldina Visconti | Art Unit<br>1752 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 November 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 14-33 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 14-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 1-6-06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

*Geraldina Visconti*  
GERALDINA VISCONTI  
PRIMARY EXAMINER

This office action is responsive to the reply filed 6 November 2006. Claims 14-33 are pending in this application. Claims 14-19 are presently under consideration.

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 14-19, in the reply filed on 6 November 2006 is acknowledged. The traversal is on the ground(s) that "claims 20-23 depend from 14 and, therefore, must include the same technical features". The Examiner notes that here is no mention of claims 24-33. Applicants arguments are not found persuasive because the polymerizable composition is useful to make other than the claimed resist of claims 20-23. The polymerizable composition of claims 14-19 is distinct from that of claims 24-29. The polymerizable composition of claims 24-29 is useful to make other than the claimed resist of claims 30-33.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 20-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6 November 2006.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1752

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaoka et al. (U.S. Patent No. 6054255).

Nakaoka et al. discloses a composition represented by formula (6) for the production of a resist comprising at least one unsaturated polymerizable monomer having at least one silicon group and at least one carbonyl group (column 7, line 63+).

Although the exemplified compounds are not entirely within the scope of the composition of the instant claims, it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to modify the substituents of said composition to achieve the optimum results.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldina Visconti whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



GERALDINA VISCONTI  
PRIMARY EXAMINER

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.